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In re Application of  
Hodge et al. :  
Application No. 10/070,526 : DECISION UNDER  
PCT No.: PCT/AU00/01055 :  
Int. Filing Date: 06 September 2000 : 37 CFR 1.42 AND  
Priority Date: 06 September 1999 :  
Atty. Docket No.: HO-P02403US0 : 37 CFR 1.47  
For: Food Product And Process :  
For Manufacturing The Same :  
:

This is in response to the papers filed on 19 November 2002.

### **BACKGROUND**

This international application was filed on 06 September 2000, and claimed a priority date of 06 September 1999. The International Bureau transmitted a copy of the published international application to the USPTO on 15 March 2001. A Demand electing the United States was filed before the expiration of 19 months from the priority date. Accordingly, the 30 month time period to file the basic national fee in the U.S. expired as of midnight on 06 March 2002.

On 06 March 2002, applicants filed *inter alia* the required basic national fee, but did not file an executed oath or declaration of the inventors.

On 20 May 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the filing of an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b).

The instant papers were filed on 19 November 2002.

### **DISCUSSION**

#### *Submission Under 37 CFR 1.42*

The declaration filed on 19 November 2002 is signed by Keith Stoodley, in lieu of deceased joint inventor Neil Stoodley. 37 CFR 1.42 provides in part that

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or

declaration, and apply for and obtain the patent.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Review of the copy of the declaration filed on 19 November 2002 reveals that it is defective because it has been altered (by modifying Neil Stoodley's postal code), but the alterations were not signed and dated. Meanwhile, the declaration was signed by Keith Stoodley, but does not state Keith Stoodley's relationship to deceased inventor Neil Stoodley, and does not state Keith Stoodley's citizenship, residence and mailing address (nor are his residence, mailing address and relationship stated on the accompanying application data sheet). The "Added Page To Declaration..." does not cure these defects in that it does not form a part of the declaration, and since it does not clearly identify Keith Stoodley's relationship to Neil Stoodley. Therefore, it would be inappropriate to grant relief under 37 CFR 1.42 on the basis of the present record.

#### *Petition Under 37 CFR 1.47*

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Petitioner has satisfied requirement (1), but has not satisfied requirements (2), (3) and (4).

Regarding requirement (1), the petition is accompanied by a fee authorization. The petition fee is being charged to counsel's deposit account 06-2375, thereby satisfying requirement (1).

Regarding requirement (2), it is not clear that non-signing joint inventor Stella Collins has refused to execute a declaration after being presented with the declaration and a complete copy of the application. Instead, based on the letter from Kristina Cornish to Ms. Collins, it appears that Ms. Collins was provided with an incomplete application (missing, at least, the complete set of drawings). Moreover, the evidence of Ms. Cornish's alleged refusal appears facially to be incomplete in that the page entitled "authority" refers to a letter from Ms. Collins to Kilburn & Strode, but no copy of this letter accompanies the petition. As such, requirement (2) has not been satisfied.

Regarding requirement (3), the petition states Ms. Collins' last known address. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the declaration is not acceptable because the request for relief under 37 CFR 1.42 has not been granted.

**DECISION**

The papers under 37 CFR 1.42 and the petition under 37 CFR 1.47 are **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and/or "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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